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PATENT
Attorney Docket No. 020375-020400US

TOWNSEND and TOWNSEND and CREW LLP

By: /Bonnie Rickles/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ian Drysdale et al.

Application No.: 09/812,036

Filed: March 19, 2001

For: METHOD AND SYSTEM FOR
PROVIDING A TARGETED
ELECTRONIC COMMUNICATION TO
A WIRELESS DEVICE USER (AS
AMENDED)

Confirmation No. 9345

Examiner: Alina A. Boutah

Technology Center/Art Unit: 2143

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on September 12, 2006 for the above-referenced application, Appellants submit this Brief on Appeal.

1. REAL PARTY IN INTEREST

First Data Corporation is the real party in interest as the assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 18-28 and 38 to 44 are currently pending in this application. All pending claims stand rejected pursuant to a Final Office Action dated May 17, 2006. The rejections of the claims are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

An Amendment After Final (dated July 11, 2006) was entered, but no claims were amended. Thus, the claims remain in the form as rejected in the Final Office Action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The application has two independent claims (claims 18 and 43).

Method claim 18 is directed to a method for providing a targeted electronic communication to a user entering a commercial establishment and having a personal wireless device (Specification, p. 3, lines 9-11; p. 7, lines 19-21). The method includes the steps of storing user specific information in a storage location (Fig. 4, step 39; p. 9, lines 24-28), providing the personal wireless device with a transceiver device (Fig. 1, transceiver 14; p. 6, lines 19-20), recognizing the presence of the personal wireless device transceiver when the user enters the establishment and the personal wireless device is within a predetermined distance from a facility communication system (Fig. 4, step 46; p. 7, lines 9-21), sending a request for user specific information from the facility communication system to the personal wireless device in response to recognizing the presence of the wireless device when the user enters the establishment (Fig. 4, step 50; p. 10, lines 3-6), retrieving the user specific information (Fig. 4,

steps 52, 54; p. 10, lines 7-13), sending the user specific information from the personal wireless device to the facility communication system (Fig. 4, step 56; page 10, lines 13-15), comparing the user specific information to predetermined criteria (Fig. 4, step 58; p. 10, lines 15-17), sending a targeted electronic communication to the wireless device corresponding to the user specific information (Fig. 4, step 60; p. 10, lines 17-20), and displaying the targeted electronic communication at the wireless device so that the communication may be used by the user while present in the commercial establishment (p. 9, lines 1-7; p. 11, line 3; p. 11, lines 22-30).

Claim 43 is a system having limitations similar to those of claim 18, but further reciting that the predetermined criteria relate to specific items at the commercial establishment (p. 10, lines 27-30), that the electronic communications sent and displayed at the wireless device is advertising (p. 11, lines 22-27), and that the advertisement pertains to both the user and to items at the establishment (p. 11, lines 27-30).

Other embodiments are recited in the dependent claims. For example, claim 20 recites that the user specific information is stored within the wireless device (p. 9, lines 27-28). Claims 21 and 28 recite that the user specific information is stored at a remote storage location (p. 9, lines 24-27). Claim 27, 42 and 44 recite that the targeted communication is an e-coupon (p. 11, lines 1-5). Claim 28 recites that the targeted communication is an advertisement (p. 11, lines 22-25). Claims 38, 39, 40 and 41 recite that the predetermined criteria relate to specific items or inventory at the commercial establishment (p. 10, lines 25-30).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 18-28 and 38-44 are rejected as being unpatentable over U.S. Patent Publication No. 2002/0095333 (“Hudda”), in view of U.S. Patent No. 6,584,448 (“Laor”), and in further view of U.S. Patent Publication No. 2002/0138372 (“Ludtke”).

7. ARGUMENT

Claims 18 and 43

For a rejection to be maintained under 35 U.S.C. §103(a), the Examiner is charged with factually supporting a *prima facie* case of obviousness. MPEP 2142. Such a *prima facie* case requires, *inter alia*, that all limitations of the claims be taught or suggested by the cited references and that there be some suggestion or motivation to combine and/or modify the reference teachings as the Examiner proposes. MPEP 2143.

Appellants believe that the Examiner has failed to establish a *prima facie* case of obviousness, and that claims 18 and 43 are allowable over the cited references. In particular, none of the applied references teach or suggest a method and system whereby the presence of the wireless device is recognized *when the user enters a commercial establishment*, and a targeted electronic communication is sent by a facility communication system in a commercial establishment to a personal wireless device *in response to the user and wireless device entering the establishment*, the communication being based on user specific information from the wireless device and a comparison of that information to predetermined criteria, and the targeted communication being displayed so that the communication may be used by the user while present in the establishment.

Hudda, the principal reference, discloses two arrangements for communicating with a consumer having a wireless device. In one arrangement (Figs. 2-5C), the consumer is already within the store, and then logs into a system. The consumer enters the UPC code of products and then gets information from the merchant as to those products. In the other arrangement (Fig. 6), the consumer is in a geographical area, logs into the system, enters product information, and the system identifies nearby store locations where the products may be purchased. Neither arrangement recognizes when the consumer enters a store or commercial establishment, as in claims 18 and 43. In addition, **Hudda** does not disclose sending a request for user specific information from the facility communication system to the personal wireless device, retrieving the user specific information, and then sending the user specific information from the personal wireless device to the facility communication system, as also recited in claims 18 and 43.

The Examiner has combined **Hudda** with **Laor** and **Ludtke**. The Examiner cites **Laor** for its teaching of “sending a request for a user specific information from a server to a

client and retrieving specific information (col. 1, lines 29-35),” and cites **Ludtke** for its teaching of “when a customer has an e-coupon stored in the PDA, the PDA can alert the user wherever he or she enters a store carrying the product covered by the coupon [0054]” (see page 3 of the Examiner’s Remarks in the final Office Action).

Laor teaches the use of a cookie which recognizes a user that has previously entered a website (server) and thereafter provides customized information in subsequent visits by the user to the website (col. 1, lines 35-44).

Ludtke teaches a PDA 10 that receives broadcasted product information when a user enters a store 50. The broadcasted product information relates to products that can be found in the store. The broadcasted information is compared to a shopping list 16 maintained in the PDA. If the PDA has an electronic coupon for one of the products in the store, the PDA can alert the user (paragraphs 0029, 0030 and 0054).

However, none of the reference discloses the recognition of the presence of a user and his/her wireless device when entering a commercial establishment, and subsequent interaction with the user to deliver targeted communications. Rather, in each reference, the user either initiates contact or passively receives information (without interaction). In **Hudda**, the user logs into the system after the user is in the store. In **Laor**, the user initiates contact with a website in order to receive information and a cookie from a server. In **Ludtke**, a store system transmits product information to *any* PDA entering or otherwise in the store, but does not *recognize* the PDA or interact with the PDA (either when it is in the store or after it has received broadcasted product information).

Accordingly, none of the references disclose, teach or suggest, either alone or as combined, the claimed features of “recognizing the presence of the personal wireless device when the user enters the commercial establishment” or “sending a request for user specific information from the facility communication system” in response to “recognizing the presence of the personal wireless device” and after the user and personal wireless device are within the commercial establishment, as recited in claims 18 and 43.

The Examiner appears to argue that recognizing the presence of a wireless device is taught or motivated in light of **Laor** at col. 1, lines 32-35, and **Ludtke** at paragraph 0054 (see page 4 of the Examiner's Remarks). Appellants find no such teaching or motivation.

In fact, Appellants believe that the cited references teach away from the claimed invention. **Hudda** and **Laor** require the user to initiate the process and log into the system before information is requested. Such an arrangement would eliminate the advantages achieved by Applicants' invention where communications are not initiated by the user, but rather by the facility communication system sensing when the user and personal wireless device enter the commercial establishment. **Ludtke** requires the user to have pre-loaded shopping lists and coupons, which necessarily requires the user to select products before entering the store, rather than the store communications system advantageously selecting and sending targeted communications based on user specific information provided by the user's personal wireless device (as in Appellants' invention).

Dependent Claims

The dependent claims all recite limitations in addition to and in combination with those of independent claims 18 and 43, and are believed allowable for at least the reasons stated above for those claims. For example, the references do not teach or suggest the combination (with limitations of the independent claims) of the limitations recited in claim 20 (the user specific information is stored within the wireless device), claims 21 and 28 (the user specific information is stored at a remote storage location), claims 27, 42 and 44 (the targeted communication is an e-coupon), claim 28 (the targeted communication is an advertisement), claims 38, 39, 40 and 41 (the predetermined criteria relate to specific items or inventory at the commercial establishment).

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

The claims pending in this application are as follows:

1-17. (Canceled)

18. (Previously Presented) A method for a facility communication system within a commercial establishment to provide a targeted electronic communication to a user entering the establishment and having a personal wireless device, comprising the steps of:

- storing user specific information in a storage location;
- providing the personal wireless device with a transceiver device;
- recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment and the personal wireless device is within a predetermined distance from the facility communication system;
- sending a request for user specific information from the facility communication system to the personal wireless device;
- retrieving the user specific information;
- sending the user specific information from the personal wireless device to the facility communication system;
- comparing the user specific information to predetermined criteria;
- sending a targeted electronic communication to said personal wireless device corresponding to the user specific information; and
- displaying the targeted electronic communication at the personal wireless device so that the communication may be used by the user while present in the commercial establishment.

19. (Original) The method of claim 18 further including the step of notifying said user that a targeted electronic communication has been received by said personal wireless device.

20. (Original) The method of claim 18 wherein said step of storing user specific information in a storage location comprises storing the user specific information within said personal wireless device.

21. (Original) The method of claim 18 wherein said step of storing user specific information in a storage location comprises storing the user specific information at a remote storage location which is accessible by the personal wireless device.

22. (Original) The method of claim 21 wherein the step of retrieving the user specific information comprises retrieving the user specific information from said remote storage location.

23. (Original) This method of claim 18 wherein said personal wireless device is a cellular phone.

24. (Original) The method of claim 18 wherein said personal wireless device is a pager.

25. (Original) The method of claim 18 wherein said personal wireless device is a personal digital assistant.

26. (Original) The method of claim 18 wherein the step of recognizing the presence of the personal wireless device transceiver when the personal wireless device is within a predetermined distance from the facility communication system comprises recognizing the presence of the personal wireless device when the user enters a facility where the facility communication system is located.

27. (Previously Presented) The method of claim 18 wherein said facility communication system is located in the commercial establishment and said targeted communication signal is an e-coupon corresponding to the user specific information for use at the commercial establishment.

28. (Previously Presented) The method of claim 18 wherein said facility communication system is located in the commercial establishment and said targeted communication is an advertisement providing data corresponding to the user specific information and relating to a product found at said commercial establishment.

29-37. (Canceled)

38. (Previously Presented) The method of claim 18, wherein the predetermined criteria is information relating to specific items present at the commercial establishment so that the targeted communication pertains to both the user and to items present at the establishment.

39. (Previously Presented) The method of claim 38, wherein the commercial establishment is a merchant location, and wherein the predetermined criteria is information relating to items for sale that are in inventory at the merchant location, so that user specific information may be compared to those items in inventory.

40. (Previously Presented) The method of claim 39, wherein the user specific information is product preferences of the user, and wherein the method further comprises matching user specific information to items in inventory prior to sending the targeted communication to the personal wireless device.

41. (Previously Presented) The method of claim 18, wherein the targeted communication is advertising and wherein predetermined criteria is information relating to specific items present at the commercial establishment, so that the advertising pertains to both the user and to items present at the establishment.

42. (Previously Presented) The method of claim 41, wherein the advertising is an e-coupon.

43. (Previously Presented) A system for providing targeted advertising from a commercial establishment to a user entering the commercial establishment, comprising:

a personal wireless device carried by the user and including a transceiver device;
and

a facility communication system resident at the commercial establishment having a sensing device for recognizing the presence of the personal wireless device transceiver when the user enters the establishment and the personal wireless device is within a predetermined distance from the facility communication system;

wherein the facility communication system at the commercial establishment sends a request for user specific information to the personal wireless device when the sensing device senses the presence of the user and personal wireless device when entering the establishment;

wherein the personal wireless device sends back to the facility communication system a response data message having the user specific information;

wherein the facility communication system compares the user specific information to predetermined criteria relating to specific items at the commercial establishment;

wherein the facility communication system sends a targeted electronic communication having advertising to the personal wireless device, the targeted communication pertaining to both the user and items at the commercial establishment; and

wherein the personal wireless device displays the targeted electronic communication so that the advertising may be used by the user while present in the commercial establishment.

44. (Previously Presented) The system of claim 43, wherein the targeted communication further comprises an e-coupon.

10. EVIDENCE APPENDIX

None

11. RELATED PROCEEDINGS APPENDIX

None